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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICK KING, DAVID WONG, PETER ALEXANDER,
CAMERON J. ESFAHANI, and DEBBIE MCDANIEL

Appeal 2009-001174
Application 09/551,303
Technology Center 2100

Decided: October 28, 2009

Before ST. JOHN COURTENAY III, CAROLYN D. THOMAS, and
STEPHEN C. SIU *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-6, 8-13, 15, 16, 18-24, 26, and 32-58. Claims 7, 14, 17, 25, and 27-31 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

THE INVENTION

Appellants' invention relates generally to data processing systems. More particularly, the present invention relates to digital processing systems which include display devices and which allow for the control of the appearance of objects displayed on the display device. (Spec. 1, ll. 6-9).

Claims 1 and 10 are illustrative:

1. A computer readable medium storing executable computer program instructions which when executed on a digital processing system cause said digital processing system to perform a method comprising:

retrieving a data value representing an appearance of an enclosure enclosing said digital processing system including a microprocessor, wherein said data value includes a value representing at least one of a machine type and a color of said enclosure of said digital processing system; and

determining an appearance of a display of said digital processing system based upon said appearance of said enclosure.

10. A digital processing system comprising:

a processor;

a display coupled to said processor;

a bus coupled to said processor;

a memory coupled to said bus, said memory storing a data value representing an appearance of an enclosure enclosing said digital

processing system including a microprocessor, said processor retrieving said data value and setting an appearance of said display based upon said appearance of said enclosure,

wherein said data value includes a value representing at least one of a machine type and a color of said enclosure of said digital processing system.

PRIOR ART

The Examiner relies upon the following reference as evidence in support of the obviousness rejection:

Glaser	US 6,392,671 B1	May 21, 2002
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THE REJECTIONS

The Examiner rejected claims 1-6, 8-13, 15, 16, 18-24, 26, and 32-58 under 35 U.S.C. § 103(a) as unpatentable over Glaser.

APPELLANTS' CONTENTIONS

1. Appellants contend that according to the claimed invention, a display of a computer may be determined based on a data value representing an appearance of an enclosure of the computer including the microprocessor. The data value also indicates the machine type and/or color of the enclosure of the computer including enclosing a microprocessor of the computer. Appellants contend that these features are absent from Glaser. (App. Br. 6).

2. Appellants contend that a mouse (or a peripheral) is not a computer and certainly does not include a microprocessor such as a CPU of a computer. (App. Br. 7). In the event that a mouse or peripheral is

considered to be a computer, Glaser discloses another computer system.
(App. Br. 7-8).

EXAMINER'S FINDINGS

The Examiner interprets the above-mentioned limitation (See Appellants' Contentions' 1) as a system in which data describing the appearance of an enclosure of the system (not necessarily the whole system) is used to affect the display of the system. (Parenthesis in original). (Ans. 9)

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Have Appellants shown the Examiner erred in finding that Glaser teaches or suggests the limitations of retrieving a data value representing an appearance of an enclosure enclosing said digital processing system including a microprocessor, wherein said data value includes a value representing at least one of a machine type and a color of said enclosure of said digital processing system, and determining an appearance of a display of said digital processing system based upon said appearance of said enclosure?

PRINCIPLES OF LAW
Claim Construction

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’”
In re Bigio, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

Obviousness

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants’ Briefs to show error in the proffered prima facie case.

Findings of Fact

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by a preponderance of the evidence:

1. Glaser discloses initiating a desktop theme change based on an exchanging event of any peripheral. (Col. 3, ll. 5-9)
2. Glaser discloses a mouse that includes identification means, for example a semiconductor memory. The identification means carries a unique identifier sufficient to identify to a computer system each unique individual mouse. (Col. 5 ll. 27-33)
3. Glaser discloses that each pointing device can have a particular motif and a unique identifier that corresponds to a particular desktop theme file stored by the computer system. (Col. 5, ll. 38-43, see also col. 3 ll. 31-37)
4. Glaser discloses a graphical user interface theme that is associated with, or “tied to,” a peripheral that is connected to a computer system. (Quotes in original) (Col. 3, ll. 23-25).
5. Glaser suggests small computers including computer memory and microprocessor, being mounted in a mouse. (Col. 8, ll. 20-27)

ANALYSIS

ISSUE 1

We decide the question of whether Appellants have shown the Examiner erred in finding that Glaser teaches or suggests the limitations of retrieving a data value representing an appearance of an enclosure enclosing said digital processing system including a microprocessor, wherein said data value includes a value representing at least one of a machine type and a

color of said enclosure of said digital processing system, and determining an appearance of a display of said digital processing system based upon said appearance of said enclosure. (*See* claim 1).

At the outset, we construe the aforementioned claim limitation to require an enclosure that encloses *the entire* digital processing system (“an enclosure enclosing *said* digital processing system including a microprocessor and a display of *said digital processing system*”). Thus, it is our view that the claim language requires a single, self contained system that includes a digital processing system including a microprocessor and a display. Based on this construction, we find that the weight of the evidence supports the Appellants’ position.

As noted above, the Examiner contends that claim 1 is interpreted as a system in which data describing the appearance of an enclosure of the system (not necessarily the whole system) is used to affect the display of the system. (See Examiner’s Findings *supra*). For the reasons discussed *infra*, we agree with Appellants that, at best, Glaser teaches at least two enclosures for the entire system. (App. Br. 8)

We find that Glaser suggests a first enclosure (pointing device) that includes memory and “may” include a microprocessor. (FF 5). However, according to Glaser, the first enclosure is attached to a second enclosure (computer). (FF 4). The second enclosure processes the identifier stored in the first enclosure and implements the desktop theme on a separate display. (FF 2-3). The appearance of the first enclosure determines the displayed desktop theme. (FF 1, 3, and 4)

Thus, we find that the Examiner's interpretation does not account for an appearance (desktop theme) based on a single enclosure that encloses the digital processing system including a microprocessor and the display, consistent with our claim construction *supra*. Therefore, we agree with Appellants that at best Glaser teaches at least two enclosures for the entire system.

Based on the record before us, we find that Appellants have shown error in the Examiner's rejection of independent claim 1. Accordingly, we reverse the Examiner's rejection of claim 1 as well as independent claims 10, 19, 32, 41, 47, 50, and 58, each of which are similarly interpreted to require a single enclosure which encloses the digital processing system including a microprocessor and a display. The rejection of dependent claims 2-6, 8-9, 11-13, 15, 16, 18, 20-24, 26, and 33-40, 42-46, 48-49, and 51-57 are also reversed based on their dependence from the aforementioned independent claims.

CONCLUSION

Based on the findings of facts and analysis above, we find that Appellants have shown the Examiner erred in finding that Glaser teaches or suggests the limitations of retrieving a data value representing an appearance of an enclosure enclosing said digital processing system including a microprocessor, wherein said data value includes a value representing at least one of a machine type and a color of said enclosure of said digital processing system, and determining an appearance of a display of said digital processing system based upon said appearance of said enclosure.

Appeal 2009-001174
Application 09/551,303

DECISION

The Examiner's decision rejecting claims 1-6, 8-13, 15, 16, 18-24, 26, and 32-58 is reversed.

REVERSED

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